

REMARKS

Favorable reconsideration is respectfully requested.

Upon entry of the above amendment, the claims will be 13-43, with claims 13-30 being withdrawn.

The above amendment is responsive to points set forth in the Official Action.

The above amendment presents a new set of claims, wherein claims 31-33 are directed to specific polyorthoesters, support for which is evident from the specification, e.g. page 7 et seq.

New claims 34-40 are based on previous claims 1 to 7, respectively.

New claim 41 replaces previous claim 8 and depends on claim 34.

In more detail, support is evident from the disclosure at page 10, lines 3-6 and pages 23-32 in the present specification.

New claim 42 is based on previous claim 9 and depends on new claim 34.

New claim 43 is based on previous claim 12.

The significance of the above amendment will become further apparent from the remarks below.

Claims 1-12 have been rejected under 35 U.S.C. 102(a) as being anticipated by Japanese patent application 2000-199936 having an effective date of July, 2000.

In reply, enclosed are translations of the three Japanese priority applications for the present application having a filing date of on or before November, 1999.

The three Japanese priority applications support the claims of this application in all essential respects.

Thus, the Japanese patent is antedated by Applicants' Japanese priority applications.

Claims 1-11 have been rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Helwing.

This rejection is respectfully traversed.

Helwing discloses a composition comprising a compound which is composed of a base component including at least one available carbonium ion mechanism base group, and covalently

bonded thereto, an active agent component such as alcohols, phenols, carboxylic acids, thiols, amines, amides, urethanes, phosphate esters, sulfonic acids and oximes. As examples of said base component, Helwing mentions ketene acetals, vinyl ethers and thio equivalents thereof (see column 7, lines 36-47).

Compound (E3-II) in column 18 of Helwing, which is relied on in the rejection, has two ring structures derived from orthoester, and is therefore included in the scope of formula (V) in original claim 11 of the present application. As apparent from the above amendment, claim 11 has been cancelled.

As is clearly seen from the definition of “n” in the new generic claim 31, the polyorthoester of the present invention has 3 to 40 orthoester-derived ring structures per molecule, and in this respect, is clearly unobvious from the compound of Helwing.

Helwing teaches or suggests no such polyorthoester having 3 to 40 orthoester-derived ring structures as shown by formula (IV) or (V), which are defined in claim 31 of the present application.

Further, as is clearly seen in EXAMPLE 3 in columns 17 and 18 of Helwing, the compound (E3-II) is a product from a reaction between the ketene acetal of (E1-II) and the diol compound of (E3-I). The polyorthoester of the present invention, on the other hand, is obtained from a reaction of (a) an orthoester, (b) a glycol compound, and (c) a compound having 3 to 40 hydroxyl groups, i.e., by a process which is unobviously different from the reaction disclosed in Helwing.

Helwing teaches or suggests nothing of producing polyorthoesters by the process as defined in claim 34 of the present application.

Therefore, the present claims are neither anticipated by, nor obvious from Helwing.

Claims 1-11 have been rejected under 35 U.S.C. 102(b) as anticipated by UK 1,128,963 and Claims 1-12 have been rejected under 35 U.S.C. 103(a) as unpatentable over UK 1,128,963.

These rejections are respectfully traversed.

UK 1,128,963 relates to orthoesters which possess high molecular weight, low vapor pressure and a high orthoester content, and to methods for the production thereof.

Compound X, as mentioned on page 6 of the UK patent cited by the rejection, has two ring structures derived from orthoester, and is therefore included in the scope of formula (V) in original claim 11 of the present application. As mentioned above, however, claim 11 has been cancelled.

As stated above with regard to Helwing, the polyorthoester of the present invention has 3 to 40 orthoester-derived ring structures per molecule, and in this respect, is unobvious from the compound of the UK patent, which has only two such ring structures.

Also, UK 1,128,963 teaches or suggests nothing about the polyorthoester of formula (IV) or (V) as defined in claim 31 of the present application.

It is clear therefore that the present invention is not only novel, but also unobvious and patentable over UK 1,128,963.


For the foregoing reasons, it is apparent that the rejections on prior art are untenable and should be withdrawn.

No further issues remaining, allowance of this application is respectfully requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact undersigned at the telephone number below.

Respectfully submitted,

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